

S/N 10/700,419

Atty Dkt No. GP-302502 (GM-0392PUS)

Remarks

Claims 1-11 are pending in this application. Claims 1-3, 6-9 and 11 have been rejected under 35 U.S.C. §102 as being anticipated by Schacher et al (3,683,618). Claims 4, 5 and 10 have been objected to. Accordingly, Claims 1-10 are currently amended.

Allowable Subject Matter

Applicants appreciate the indication that claims 4, 5 and 10 would be allowable if written in independent form to overcome the rejection under 35 U.S.C. §102(b). The limitations of claim 4 have been incorporated into claim 1; therefore, claim 1 is allowable as indicated by the Examiner. Claim 10 has been written in independent form. Therefore, claims 1-6 and 10 are believed to be allowable.

Claim Rejections - 35 U.S.C. § 102

Claims 1-3, 6-9 and 11 are rejected under 35 U.S.C. §102(b) as being anticipated by Schacher. For a rejection to be proper as an anticipation under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the § 102 reference. "A claim is anticipated **only if each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See MPEP §2131.

Claim 1 and its dependent claims are now allowable as indicated by the Examiner, with the incorporation of the claim 4 limitations into claim 1.

Claim 7 has been amended to incorporate the limitation of "communicating said source of transmission line pressure with the clutch cylinder via a fill piston until the fill piston bottoms out" as previously recited in claim 8. Specifically, the amended claim 7 recites

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A method for applying and releasing a clutch piston in a clutch cylinder, the method comprising: providing a source of transmission line pressure; providing a controllable source of pressurized oil having a signal pressure; and alternately communicating the clutch cylinder with the source of transmission line pressure and the controllable source of pressurized oil to control application and release of the clutch piston; wherein said step of alternately communicating comprises, when applying the clutch piston, communicating said source of transmission line pressure with the clutch cylinder via a fill piston until the fill piston bottoms out, and then communicating said controllable source of pressurized oil to the clutch cylinder to cause a smooth, controlled clutch application. (underline added for emphasis)

Schacher et al. teach that the auxiliary piston means 13 is incapable of bottoming out as chamber 9 is continuously kept full.

[I]n this invention, chamber 9 is continuously kept filled with fluid, and an auxiliary piston means 13 is provided in a chamber directly connecting with the chamber 9 and having a face 15 exposed in that chamber. (col 1, lines 55-59).

Conversely, Applicants' amended claim 7 requires that the communication between the source of transmission line pressure with the clutch cylinder (via the fill piston) 32 occurs until the fill piston bottoms out – a step clearly not anticipated by the Schacher device. Claim 11 incorporates a similar limitation. Accordingly, Applicants submit that claims 7 and 11 are not anticipated by Schacher et al.

Claim 9 ultimately depends from claim 7 and is therefore allowable for at least the same reasons that claim 7 is allowable.

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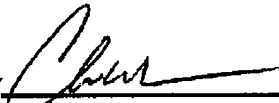
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CONCLUSION

Applicants believe this amendment and remarks in support thereof is fully responsive to the Office Action mailed February 28, 2005 and places the case in condition for allowance.

Respectfully submitted,

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